

Attorney Docket No.: 10179.204-US

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Schneider et al.

Confirmation No: 4404

Serial No.: 09/869,877

Group Art Unit: 1634

Filed: July 6, 2001

Examiner: J. Einsmann

For: Laccase Mutants

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11/5/02

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, DC 20231

Sir:

This paper is filed in response to the Office Action mailed September 26, 2002 that made a restriction requirement between the following groups:

Group I – claims 1 and 12-15 drawn to *Coprinus* laccase variants,

Group II – claim 2 drawn to *Myceliophthora thermophila* laccase variants,

Group III – claims 3-8 drawn to nucleic acids encoding *Coprinus* laccase variants,

Group IV – claims 9 and 10 drawn to methods for inhibiting dye transfer,

Group V – claims 9 and 11 drawn to methods for bleaching a textile.

The Office Action also requested Applicants to elect a single laccase variant for prosecution.

Applicant respectfully traverses the restriction and election of species requirements. The basis for traverse is that the Office Action applied an incorrect standard for determining whether a restriction requirement was proper.

The above-captioned application was entered into the national stage under 35 U.S.C. 371, i.e. filed via the PCT. For these types of applications, the PTO follows the rules set forth in 37 C.F.R. 1.401 - 1.499.

The standard for determining whether unity of invention exists during the national stage, i.e. whether a restriction requirement may be imposed, is set forth in 37 C.F.R. 1.475(a) which provides:

An international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.... Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving

one or more of the same or corresponding special technical features. The expression 'special technical features' shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

Moreover, under 37 C.F.R. 1.475(b), an international or a national stage application in the national stage complies with the unity of invention requirement if the claims are drawn only to one of the following combinations of categories:

- (1) A product and a process specially adapted for the manufacture of said product; or
- (2) A product and a process of use of said product; or
- (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
- (4) A process and an apparatus or means specifically designed for carrying out the said process; or
- (5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specially designed for carrying out the said process.

In the present case, Groups I, II and III are directed to laccase variants and therefore relate to a single inventive concept. Moreover, the inventions designated IV and V are directed to processes using said laccase variants and therefore also relate to the same single inventive concept as Groups I-III.

Significantly, no objection to unity of invention was raised at any point of the PCT prosecution by the International Searching Authority.

Applicants also submit that there would not be a serious burden on the examiner if restriction were not required, since the same prior art would have to be searched and considered for examining Groups I-V.

Moreover, election of species requirements are not permitted under the Patent Cooperation Treaty and therefore cannot be made in US applications filed under 35 U.S.C. 371.

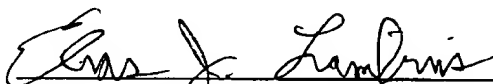
For the foregoing reasons, Applicants submit that the restriction requirement is improper. Applicants respectfully request reconsideration and withdrawal of the restriction requirement.

In order to be fully responsive, Applicants hereby elect the invention of Group II, and a laccase comprising a substitution at position 177 as the specific laccase variant. Claim 2 reads thereon. Applicants hereby reserve the right to file continuing applications directed to the nonelected subject matter.

The Examiner is hereby invited to contact the undersigned by telephone if there are any questions concerning this response or application.

Respectfully submitted,

Date: October 25, 2002



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